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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,335	11/26/2001	Junji Nagaoka	MTS-3288US	7419

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,335

Applicant(s)

NAGAOKA ET AL.

Examiner

Jorge L. Ortiz-Criado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

The “readable medium having a program”/“a computer-processable medium carrying a program” claims 13-16 could be infringed without infringing upon the respective base claims drawn to an apparatus/method. Possession of a readable/computer-processable medium including instructions to perform a method that infringes on the claimed apparatus/method does not necessarily mean that the actual method has been performed and therefore the apparatus/method of the base claim is not necessarily infringed. Hence, claims 16 are improper dependent claims as failing the Infringement test outlined in MPEP 608.01(n) II.

TREATMENT OF IMPROPER DEPENDENT CLAIMS, III. INFRINGEMENT TEST.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-5 and 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim U.S. Patent No. 5,828,637.

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Regarding claim 1, Kim discloses an optical disk apparatus comprising:

an optical head having lens means of converging light from a light source onto an optical disk; and a photodetector for detecting the light thus converged and then reflected from said optical disk (See col. 12, line 63 to col. 13, line 46; Fig. 7);

tracking error signal generating means of generating a tracking error signal in order to perform tracking control on the basis of said detected light (See col. 12, line 63 to col. 13, line 46; Fig. 7, signals "TEp");

detecting means of detecting a disk tilt "DT" indicating the amount of tilt of said optical head relative to said optical disk (See col. 12, line 63 to col. 13, line 46; Fig. 7, signal "Ts"); and

calculating means of calculating a lens shift LS indicating the amount of shift of said lens means relative to said optical head, according to a predetermined rule on the basis of said generated tracking error signal and said detected disk tilt DT (See col. 13, line 63 to col. 14, line 56; fig. 7, ".delta. R").

Regarding claim 2, Kim discloses wherein said predetermined rule is expressed by the following

$$\text{Equation } T = a \cdot LS + b \cdot DT$$

which is satisfied among: the value T of said generated tracking error signal; said detected disk tilt DT; and said lens shift LS to be calculated; when predetermined constants a and b are given (See col. 14, line 56, equation (12)).

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Regarding claim 3, Kim discloses wherein said detecting means can detect said disk tilt DT (See col. 7, lines 21-52; col. 12, line 63 to col. 13, line 46; Fig. 7, signal "Ts")

Regarding claim 4, Kim discloses an optical head driving means of driving said optical head within the cross section in a radius direction of said optical disk on the basis of the result of said detection of said disk tilt DT, wherein when said tracking error signal is detected, said optical head is driven so that said detected disk tilt DT substantially becomes zero (See col. 7, lines 21-52; col. 12, line 63 to col. 14, line 56; Fig. 7)

Regarding claim 5, Kim discloses wherein: said detecting means can detect the reproduction state of the information from said optical disk; said optical disk apparatus comprises optical head driving means of driving said optical head within the cross section in a radius direction of said optical disk on the basis of the result of said detection of said reproduction state of said information; and when said tracking error signal is detected, said optical head is driven so that said reproduction state of said information becomes optimum (See col. 12, line 63 to col. 14, line 56; Fig. 7)

Regarding claim 9, Kim discloses wherein said tracking error signal is detected in "the mirror region" of said optical disk (See col. 12, line 63 to col. 13, line 56; Fig. 7; reflective part, where the light is reflected).

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Regarding claim 10/(claim 3), Kim discloses wherein said tracking error signal is detected by detecting the average level of said tracking error signal in the OFF-state of tracking control in the data region in the vicinity of the disk radius position of said optical disk where said disk tilt DT or said lens tilt LT is detected (See col. 12, line 63 to col. 13, line 56; Fig. 7 “phase difference of the tracking error signal”).

Regarding claim 11, Kim discloses conveying means of conveying said optical head in a radius direction of said optical disk on the basis of said calculated lens shift LS (See col. 7, lines 21-52; col. 12, line 63 to col. 14, line 56; Fig. 7).

Regarding claim 12, Method claims 12 are drawn to the method of using the corresponding apparatus claimed in claim 1. Therefore method claims 12 correspond to apparatus claim 1 and are rejected for the same reasons of anticipation as used above.

Regarding claim 13/(claim1), A readable medium having a program for causing a computer to serve as all or part of said tracking error signal generating means, said detecting means, and said calculating means (This feature is inherent to Kim, since Kim inherently provides a computer to control the apparatus).

Regarding claim 14, A readable medium having a program for causing a computer to carry out all or part of said generating step, said disk tilt detecting step, and said calculating step

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of said method of calculating the amount of lens shift (This feature is inherent to Kim, since Kim inherently provides a computer to control the apparatus using the method) .

Regarding claim 15/(claim1), A computer-processable medium carrying a program for causing a computer to serve as all or part of said tracking error signal generating means, said detecting means, and said calculating means of said optical disk (This feature is inherent to Kim, since Kim inherently provides a computer to control the apparatus and the program saved in a readable medium to be used by the computer) ,

Regarding claim 16, A computer-processable medium carrying a program for causing a computer to carry out all or part of said generating step, said disk tilt detecting step, and said calculating step of said method of calculating the amount of lens shift (This feature is inherent to Kim, since Kim inherently provides a computer to control the apparatus using the method)

Response to Arguments

Applicant's arguments filed 01/13/2005 have been fully considered but they are not persuasive.

Applicants argues that Kim does not teach or suggest “calculating means of calculating a lens shift LS indicating the amount of shift of said lens means relative to said optical head, according to a predetermined rule on the basis of said generated tracking error signal and said detected disk tilt DT.

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The examiner cannot concur because the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As claimed Kim discloses calculating means of calculating a lens shift LS indicating the amount of shift of said lens means relative to said optical head, according to a predetermined rule on the basis of said generated tracking error signal and said detected disk tilt DT as outlined in col. 14, line 56; fig. 7, calculating “.delta. R”; equation (12) ,

Furthermore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-7624. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm), Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne R. Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUSAN MCFADDE
PRIMARY EXAMINER